

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentee: Stephen Almeida
Title: Multiple Pulse Photo-Epilator
Serial No.: 09/173,422
Patent No.: 6,228,074
Filing Date: October 15, 1998
Issue Date: May 8, 2001
Date: September 28, 2011

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-145

Sir:

PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT
OF MAINTENANCE FEE IN AN EXPIRED PATENT
UNDER 37 CFR §1.138 (b)

DECLARATION OF Mark S. Leonardo, Esq.

I, Mark S. Leonardo, of the law firm Brown Rudnick LLP, being the Chair of the Intellectual Property Department at all times relevant to the facts and circumstances concerning the transfer of files for the above-referenced patent, hereby swear that the expiration of the above referenced patent for failure to pay maintenance fees was unavoidable and unintentional for the following supporting reasons;

I. BACKGROUND

1. I am a citizen of the United States and am more than twenty-one (21) years of age;
2. I am presently a partner at the law firm Brown Rudnick LLP ("Brown Rudnick") (<http://www.brownrudnick.com/>), where I have been practicing since 1999;

3. Before joining Brown Rudnick, I was an associate at the law firm of Dilworth & Barrese, LLP from about 1997 until 1999;

4. Before joining Dilworth & Barrese, LLP, I was a Patent Examiner in the Electro-Mechanical and Biomedical Arts Groups at the USPTO, from 1995 to 1997;

5. I earned a J.D. from the Cleveland-Marshall College of Law in 1995, and a Bachelors of Science in Mechanical Engineering from the University of Massachusetts in 1992. I have been a member of the Commonwealth of Massachusetts Bar since about 1996 and a Registered Attorney with the U.S. Patent and Trademark Office (“PTO”) since 1995 (Registration No. 41,433). My practice includes Intellectual Property (“IP”) law, with a focus on patent prosecution, due diligence, and freedom to use opinions in the mechanical, electro mechanical and medical device arts;

6. On or about November 2006, I was promoted to the Chair of the Intellectual Property Department at Brown Rudnick;

7. During May of 2007 several of my colleagues at Brown Rudnick’s Boston office left to join the law firm of Seyfarth Shaw (“Seyfarth”) in its Boston office;

8. Following the departure of the Brown Rudnick personnel to Seyfarth, we received transfer requests from various clients to transfer their files in both electronic and physical form to Seyfarth;

9. As a result of these transfer requests, Brown Rudnick transferred the physical files. These files amounted to the work product of several attorneys over the period of several decades and totaled in excess of 700 hundred active files and several thousand inactive files;

10. As a further result of these transfer requests, Brown Rudnick transferred the electronic files. These electronic files amounted to the work product of several attorneys over the period of several decades. These electronic files consisted of electronic documents and the respective docketing records for this collective work;

11. To ensure the orderly transfer of these files, we called upon a member of our records management group, Keith Schultz, who had over seven (7) years of experience in the area of Information Technology (“IT”), file administration, file room management and who has worked at Brown Rudnick since 1999;

12. Mr. Schultz is experienced in file room management and IT and understands the importance and issues in the storage, retrieval and transfer of both physical and electronic client files;

13. Mr. Schultz worked under our file room manager, Deborah Hopkins, who at the time of the Seyfarth file transfer was our professional file room manager who was responsible for matters concerning our clients’ files. Ms. Hopkins had significant experience in file room management;

14. As a result of these transfer requests and in order to ensure that the clients’ matters were protected, we worked with Seyfarth and our patent docketing software company, CPI, to transfer the client’s electronic docket entries to Seyfarth as requested by client transfer instructions;

15. We believed that the steps taken during the transfer of files had redundancy to ensure that important client matters would be protected in the form of the transfer and receipt of physical files, but also the transfer and receipt of corresponding electronic docket entries;

16. On or about September 1, 2011, a patent expiration notice concerning US Patent No. 6,595,986 (the “Notice”) was received by Brown Rudnick (“Expired Patent”). The expiration was based upon the failure to pay maintenance fees. The Notice referenced a former client of Brown Rudnick, which had requested that its files be transferred to Seyfarth in May of 2007;

17. Consistent with Brown Rudnick’s customary practice, an electronic copy of the Notice was e-mailed to the docketing clerk at Seyfarth;

18. The Expired Patent was later understood by me to be a CIP application of the above-captioned patent ("Petition Patent") for a client, Stephen Almeida, who according to our records, had requested that Brown Rudnick transfer its files to Seyfarth on or about May 16, 2007;

19. It is my understanding that several days later we received a call from Seyfarth seeking the patent files related to both the Expired Patent and the Petition Patent. Our records reflected that these files had been transferred to Seyfarth on or about May 24, 2007;

20. On or about December 7, 2011, I received a call from my former colleague, John C. Serio (Serio), seeking my assistance concerning the Petition Patent. During this call, Serio disclosed the contents of an adverse PTO decision concerning a petition to revive the Petition Patent. Serio indicated that the PTO was seeking declarations from Brown Rudnick concerning the Petition Patent. Serio explained that during their investigation it became apparent that Seyfarth did not believe it had received either electronic or physical files in their possession related to the Expired Patent or Petition Patent;

21. Based upon the nature of Serio's call, I asked if he could share the decision of the office to assist us with our investigation and the preparation of our declarations. Serio sent along a copy of the Petition Decision to us at Brown Rudnick;

22. Based upon information received during Serio's call and the Petition Decision, we conducted an investigation of the file transfer related to the Expired Patent, the Petition Patent and other related files of this client;

23. During the course of Brown Rudnick's investigation, we determined that we possessed two non-patent related files for this client, but did not find any files related to the Expired Patent or Petition Patent. According to our records, Brown Rudnick transferred these files along with numerous unrelated patent files on or about May 24,

2007 to Seyfarth. During our investigation, we did not locate any receipt for the transfer of these files to Seyfarth;

24. As part of our investigation, we determined that we received a reminder notice from the USPTO concerning the Expired Patent, and we believe we received a reminder notice from the USPTO concerning the Petition Patent. We believe that both expiration notices received by us were forwarded to Seyfarth, as is our firm's customary practice, but only have evidence of transmittal of the second notice concerning the Expired Patent;

25. As a further part of our investigation, we confirmed that we made arrangements to have the client docket entries on the CPI system for the Expired Patent and Petition Patent transferred to Seyfarth, but in doing so, the transfer only effected a transfer of selected files other than the Expired Patent and the Petition Patent. During the course of our investigation it was determined that the transferred selected files concerned non-patent matters for the client and contained no docket information regarding the Expired Patent and the Petition Patent.

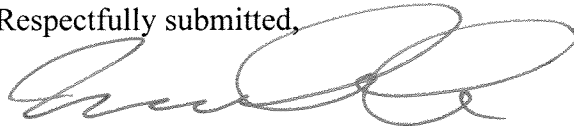
26. A redundant docketing system is maintained by Brown Rudnick. These systems are maintained by an experienced docketing clerk and a backup docketing clerk using current best practices in the IP field. One system is maintained with the aid of a computer software program, CPI, which is to my understanding the same computer software program used by Seyfarth. Accordingly, because of the client's transfer instructions and our internal records showing the transfer of this client to Seyfarth, Brown Rudnick's docketing system contained no maintenance fee information for the Expired Patent and its related Petition Patent.

27. Since Brown Rudnick's internal systems showed that we were no longer the attorneys of record for the Expired Patent and Petition Patent, our docketing systems did not contain the docketing information for the payment of any maintenance fees as our records reflected the transfer of the files in question. Accordingly, it is submitted that

any abandonment of this application was unintentional and unavoidable and it is respectfully requested that this Petition to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expired Patent under 37 CFR 1.378 (b) be granted.

28. I declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true. I further declare that these statements were made with the knowledge and understanding that willful false statements and the like so made are punishable by fine, or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of any revived U.S. patent.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Mark S. Leonardo', written over a horizontal line.

Dated January 18, 2012

Mark S. Leonardo
Brown Rudnick LLP
One Financial Center
Boston, MA 02211
Tel.: (617) 856-8145